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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK VENEGAS, JR.

Appeal 2008-5559
Application 09/829,033
Technology Center 2800

Decided:¹ May 22, 2009

Before EDWARD C. KIMLIN, TERRY J. OWENS, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 the final rejection of claims 1-11. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

We AFFIRM.

Appellant claims a lighting assembly for use with a stanchion extending outwardly from a ground surface (claim 1).

Claim 1 is illustrative:

1. A lighting assembly for use with a stanchion extending outwardly from a ground surface comprising:

an elongated tubular body having an open end and a closed end defining an interior cavity, the open end and the interior cavity of the elongated tubular body being dimensioned to receive the stanchion substantially entirely therein such that the open end is proximate to or in contact with the ground surface; and

a lighting assembly, having a light source interconnected to a power source, the light assembly being secured relative to the tubular body so that the light is visible exteriorly of the interior cavity.

The Examiner relies on the following prior art references as evidence of unpatentability:

Morse, Jr.	3,855,924	Dec. 24, 1974
Padilla	4,819,135	Apr. 4, 1989
Moore	5,121,307	Jun. 9, 1992

The appealed rejections are as follows:

1. Claims 1-6 are rejected under 35 U.S.C. § 103 as being unpatentable over Moore.
2. Claims 7 and 8 are rejected under 35 U.S.C. § 103 as being unpatentable over Moore in view of Morse, Jr.
3. Claims 9-11 are rejected under 35 U.S.C. § 103 as being unpatentable over Moore in view of Padilla.

With regard to rejection (1), Appellant argues claims 1-6 as a group of which we select claim 1 as representative in rendering our decision.

With regard to rejection (2), Appellant argues claims 7 and 8 as a group of which we select claim 7 as representative in rendering our decision.

With regard to rejection (3), Appellant argues claims 9-11 as a group of which we select claim 9 as representative in rendering our decision.

Rejection (1): § 103 over Moore

STATEMENT OF THE CASE

Appellant argues that Moore does not teach or suggest “an open end [of the elongated tubular body of the lighting assembly] is proximate to or in contact with the ground surface” as required by claim 1 (App. Br. 2-3). Appellant contends that Moore’s cover could not extend down to a ground surface due to the wires and other obstacles the telephone and utility poles are designed to produce, and extending the cover down would defeat a purpose for which the prior art is intended (App. Br. 3).

The Examiner contends that changing the length of Moore’s cylindrical housing 11 to extend the length of the pole would have been a mere change in the size of the housing and would have provided better protection to the pole as supported by the admitted prior art in the “Background of Invention” section of the Specification (Ans. 4-5).

ISSUE

Has Appellant shown that the Examiner reversibly erred in determining that it would have been obvious to change the length of Moore’s cylindrical housing such that “the open end is proximate to or in

contact with the ground surface” as required by claim 1? We decide this issue in the negative.

PRINCIPLES OF LAW

For a *prima facie* case of obviousness all the claim features must be taught or suggested by the applied prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974).

The applicant bears the procedural burden of showing error in the Examiner’s rejections. *See, e.g., In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness”) (citation and internal quote omitted).

FACTUAL FINDINGS (FF)

1. The Examiner finds that Moore discloses a covering for a pole.

Moore’s covering has an elongated tubular body for positioning over a pole with a light on the tubular body (Ans. 4). Appellant does not dispute this finding (App. Br. 2-3).

2. Appellant does not contest the Examiner’s determination that:

It would have been obvious . . . to modify the lighted assembly of Moore . . . by extending the length of the elongated tubular body, and accommodating entire stanchion within itself, or making its open end proximate the ground, since such a modification would have involved a mere change in size of the component. In addition, encasing the stanchion substantially entirely would shield its surface from damage resulting from external moving elements, and improvement in aesthetic appearance . . . The above-indicated motivation is also supported by the prior art admitted by the applicant, and included in the section entitled “Background of Invention” of the disclosure. (Ans. 4-5; App. Br. 2-3).

3. Moore discloses a solar powered strobe light serving as a warning device for low flying aircraft (col. 1, ll. 7-9). The strobe light may operate on or near tall structures and other locations where typical means of powering warning devices is hindered or prohibited (col. 1, ll. 15-20).
4. Moore discloses that the strobe light may be mounted on a tower, pole or other structure and used as an emergency marker or permanent safety fixture particularly for helicopters or other low flying aircraft (col. 2, ll. 12-17; 40-45). Moore does not limit the size of the pole or structure on which the strobe light is mounted.

ANALYSIS

Appellant contends that the claim feature requiring that the bottom end of the cover is proximate to, or in contact with, a ground surface distinguishes over Moore. The Examiner admits that Moore does not specifically teach that the open end of the lighting assembly is proximate to the ground (Ans. 4). However, Appellant has not shown error in the Examiner's determination that it would have been obvious to lengthen Moore's tubular body to cover a pole such that the end of the covering is proximate to or in contact with the ground surface because such is a mere change in size which would better protect the stanchion (Ans. 4-5).

Rather, Appellant contends that lengthening Moore's tubular body would defeat a purpose of the telephone pole, on which the Moore's light assembly is mounted, by interfering with the wires or beams thereon (App. Br. 3). However, Moore does not appear to limit the size of the pole or structure on which the strobe light may be mounted. Instead, Moore seems to indicate that the critical feature is that the strobe light provides an

emergency marker or permanent safety fixture for low flying aircraft. In other words, the strobe light may be attached to smaller poles or structures as long as it provides relevant information to helicopters and low flying aircraft. Accordingly, Appellant's argument is not persuasive.

We further note that whether the claimed lighting assembly has an open end proximate to or in contact with the ground surface depends upon the size of the stanchion, which is not claimed. In other words, it would have been obvious to place Moore's light assembly on a stanchion sized such that the light assembly's tubular body has its open end proximate to or in contact with a ground surface. As noted above, Moore does not limit the size of the pole on which the lighting assembly can be mounted.

For the above reasons, we determine that Appellant has not shown that the Examiner erred in determining that it would have been obvious to modify Moore's lighting assembly such that the open end of the assembly is proximate to or in contact with a ground surface. Accordingly, we affirm the Examiner's § 103 rejection of claims 1-6 over Moore.

Rejections (2) and (3): § 103 Rejections over Moore in view of Morse, Jr. and Moore in view of Padilla

STATEMENT OF THE CASE

With regard to each rejection, Appellant argues that there is no motivation for combining the teachings of Morse, Jr. or Padilla with Moore's lighting assembly (App. Br. 4-5). Appellant further argues that Morse, Jr. and Padilla are non-analogous art (App. Br. 4 and 6).

ISSUES

1. Has Appellant shown that the Examiner erred in finding that Morse, Jr. and Padilla are analogous art to the claimed invention? We decide this issue in the negative.
2. Has Appellant shown that the Examiner erred in finding reasons for the combining the teachings Morse, Jr. or Padilla with Moore? We decide this issue in the negative.

PRINCIPLES OF LAW

Motivation may be found in the nature of the problem to be solved, the teachings of the pertinent references or from the ordinary knowledge of those skilled in the art. *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

When determining whether a claimed invention would have been obvious over a combination of references, “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

FINDINGS OF FACT (FF)

3. Appellant states that the problem the claimed invention is concerned with is “lighted stanchions” (App. Br. 5).

4. The Specification states that the present invention is related generally to protective covers for stanchions (Spec. 1). The Specification further states the invention is directed:
[M]ore particularly to a protective cover with an integrated lighting assembly for the purpose of providing illumination around the stanchion in darkness or other low visibility conditions. (Spec. 1).
5. The Specification states that it is known to customize stanchion covers to display a customer logo or advertisement (Spec. 2). The Specification further states that “[t]he elongated tubular body 22 can be customized to display a message, such as an image or stenciled letters 40” (Spec. 7).
6. Morse, Jr.’s invention is directed to new and useful improvements in stencils for making signs consisting of letters, numerals or both (col. 1, ll. 8-12).
7. Morse, Jr. further discloses that the invention provides a stencil which is “adapted to conform snugly to a curved, or rounded, surface which is to be painted in order to make a neat and legible sign” (col. 1, ll. 27-31).
8. Morse, Jr. discloses that the stencil may be used to form signs on round posts (col. 4, ll. 12-20).
9. Padilla’s invention is a bicycle light device and a new and improved lighting device which provides enhanced durability and visibility (col. 1, ll. 6-10).
10. Padilla discloses that the lighting device uses light emitting diodes (LEDs), which are more durable and provide an

inexpensive and efficient manufacture, in lieu of conventional light bulbs (col. 1, ll. 20-25, col. 4, ll. 31-38).

11. Padilla discloses that the lighting device makes the user more visible at night (col. 1, ll. 6-10).

ANALYSIS

Issue 1: Analogous Art

We begin our analysis by addressing Appellant's analogous art arguments. Appellant too narrowly states that the problem to be solved by the invention is "lighted stanchions." While Appellant discloses providing a light assembly to the stanchion cover to illuminate the stanchion, Appellant further discloses that a stencil may be used to provide markings on the cover presumably to further enhance the visibility of the device as well as improve the aesthetics of the cover. Therefore, we determine that the problem to be solved by Appellant is to enhance the visibility of the stanchion or post as well as improving its aesthetics.

Applying our broader statement of the problem to be solved to the facts of the appeal, Morse, Jr.'s use of a stencil to provide a legible and neat sign on a post would have increased the visibility of a post, as well as enhancing the aesthetics of the post. In other words, Morse Jr.'s invention is directed to the same problem Appellant sought to solve (i.e., enhancing the visibility and aesthetics of a post or stanchion). Accordingly, we find that Morse, Jr.'s invention is directed to the same problem as Appellant's invention and is analogous art.

With regard to Padilla, Appellant's argument focuses solely on the problem to be solved by Padilla as establishing that Padilla is non-analogous

art (App Br. 6). However, Padilla's invention provides a lighting device to increase visibility of an object (i.e., a bicycle). Similarly, Appellant's invention uses a light assembly to increase visibility of a stanchion or post. Accordingly, we find that Padilla's and Appellant's problem to be solved is the same problem.

We also note that Padilla is in the same field of endeavor as Appellant's claimed invention. Specifically, Appellant's claimed invention is directed to a lighting assembly. Similarly, Padilla's device is directed to a lighting assembly. That Appellant intends to use the lighting assembly for a stanchion and Padilla intends to use the lighting assembly for a bicycle, does not change that Padilla and Appellant's invention are directed to lighting assemblies. Appellant does not contest that Padilla is in the same field of endeavor as Appellant's claimed invention (App. Br. 6).

For the above reasons, we find that Morse, Jr. and Padilla are analogous art. We now consider Appellant's motivation arguments.

Issue 2: Motivation

Appellant contends that there is no reason to combine Morse Jr. with Moore because the prior art does not each or suggest the combination (App. Br. 4). However, Appellant fails to appreciate that motivation for a combination of references may be found in the prior art itself, the nature of Appellant's problem to be solved or knowledge of one of ordinary skill in the art. *Rouffet*, 149 F.3d at 1355-56.

The Examiner finds that motivation exists for combining Morse, Jr.'s stencil with Moore's post cover to display messages in a simple manner and with cost savings (Ans. 6). Such a motivation appears to be drawn from the

knowledge of one ordinary skill in the art and nature of the problem to be solved. Specifically, adding a sign to a post increases the aesthetics and visibility of the post such that the nature of the problem to be solved by the Moore and Morse, Jr. would have rendered the combination obvious.

Also, adding signage to a post to increase the visibility and improve aesthetics of the post would have been within the knowledge of one of ordinary skill in the art. Indeed, Appellant admits that addition of stanchion or post covers customized with logos or advertisements is known in the art to increase aesthetics and thus, visibility (Spec. 2).

Accordingly, we determine that Appellant has failed to show error in the Examiner's finding that there is a reason for combining Morse, Jr.'s stenciling to form an image with Moore's post cover.

With regard to Padilla, the Examiner finds that it would have been obvious to modify the tubular cover of the lighted assembly of Moore with the tubular body and LEDs of Padilla's lighting assembly for the "benefits and advantages of high attention value displays, and for traffic safety (Warning) in dark" (Ans. 7). The Examiner further finds that Padilla's LEDs would impart "benefits of high energy efficiency, compactness and long operational life" (Ans. 7). We agree.

Padilla and Moore both use lighting assembly to attract attention of bystanders for safety. Moore uses a strobe light and Padilla uses flashing LEDs. Padilla further teaches that LEDs are durable and provide for efficient and inexpensive manufacture when compared to conventional bulbs. Accordingly, the references provide reasons for modifying Moore's tubular body with a strobe light to use Padilla's LEDs: to provide an attention getting display that is energy efficient and durable.

Appellant contends that there would be no reason for modifying Moore's lighting assembly with Padilla's lighting assembly because Moore's device is intended to be mounted on top of telephone poles such that the desirability of an eye-catching display makes little sense (App. Br. 5). Contrary to Appellant's argument, the Examiner's reason for the modification makes perfect sense. Moore's invention uses a strobe light to attract the attention of aircraft. Accordingly, using Padilla's attention-attracting, energy efficient light assembly in lieu of a strobe light would have been obvious. Such a modification is nothing more than the predictable use of a prior art element (i.e., LEDs) according to its established function (i.e., energy efficient light production). *KSR*, 550 U.S at 417.

For the above reasons, we determine that Appellant has not shown that the Examiner erred in determining that there are reasons for modifying Moore's light assembly with the teachings of Morse, Jr. or Padilla.

DECISION

We affirm the Examiner's § 103 rejection of claims 1-6 over Moore.

We affirm the Examiner's § 103 rejection of claims 7 and 8 over Moore in view of Morse, Jr.

We affirm the Examiner's § 103 rejection of claims 9-11 over Moore in view of Padilla.

The Examiner's decision is affirmed.

Appeal 2008-5559
Application 09/829,033

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v)(2008).

ORDER
AFFIRMED

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